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Douglas U. Mennie

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EXAMINER

SWARTZ, JAMIE H

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Please find below and/or attached an Office communication concerning this application or proceeding.

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

7
8 *Ex parte* DOUGLAS U. MENNIE,
9 WILLIAM J. JONES, and
10 MARK C. MUNRO
11

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13 Appeal 2009-006570
14 Application 10/084,856
15 Technology Center 3600
16

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18 Decided: December 28, 2009
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21 Before HUBERT C. LORIN, ANTON W. FETTING, and
22 BIBHU R. MOHANTY, *Administrative Patent Judges*.
23 FETTING, *Administrative Patent Judge*.

24 DECISION ON APPEAL
25

1 STATEMENT OF THE CASE

2 Douglas U. Mennie, William J. Jones, and Mark C. Munro (Appellants)
3 seek review under 35 U.S.C. § 134 (2002) of a final rejection of claims 258-
4 261 and 267-270, the only claims pending in the application on appeal.

5 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b)
6 (2002).

7 SUMMARY OF DECISION¹

8 We AFFIRM.

9 THE INVENTION

10 The Appellants invented a document processing system and automatic
11 teller machine and currency redemption machine (Specification 1:5-6).

12 An understanding of the invention can be derived from a reading of
13 exemplary claim 258, which is reproduced below [bracketed matter and
14 some paragraphing added].

15 258. A method of redeeming currency from a customer at a
16 self-service machine, comprising:

17 [1] receiving money input by said customer, said act of
18 receiving money input by said customer comprising

¹ Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed September 10, 2008) and Reply Brief ("Reply Br.," filed January 15, 2009), and the Examiner's Answer ("Ans.," mailed November 21, 2008), and Final Rejection ("Final Rej.," mailed December 31, 2007).

1 substantially simultaneously receiving, in a bulk coin
2 receptacle, randomly oriented bulk coins input by said
3 customer;

4 [2] singulating the bulk coins using a coin separation device;

5 [3] discriminating between authentic and non-authentic
6 forms of said money including discriminating between valid
7 coins and invalid coins of said bulk coins;

8 [4] determining a total value of said authentic forms of said
9 money input by said customer; and

10 [5] dispensing a card having a storage medium for storing a
11 monetary value that is related to said total value.

12

13

THE REJECTIONS

14

The Examiner relies upon the following prior art²:

Avnet et al.	US 5,291,003	Mar. 1, 1994
Smith et al.	US 5,641,050	Jun. 24, 1997

15

16

Claims 258-261 and 267-270 stand rejected under 35 U.S.C. § 112, first
17 paragraph, for failing to comply with the written description requirement.

18

19

Claims 258-261 and 267-270 stand rejected under 35 U.S.C. § 112,
20 second paragraph, as being indefinite for failing to particularly point out and
21 distinctly claim the subject matter which the Appellants regard as the
invention.

22

23

Claims 258-261 and 267-270 stand rejected under 35 U.S.C. § 103(a) as
unpatentable over Smith and Avnet.

ISSUES

The issues pertinent to this appeal are:

- Whether the Appellants have sustained the burden of showing that the Examiner erred in rejecting claims 258-261 and 267-270 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement.
 - This pertinent issue turns on whether the specification describes a bulk coin receptacle and accepting bulk coins such as a person with ordinary skill in art would have understood that the Appellants had possession of the claimed invention.
- Whether the Appellants have sustained the burden of showing that the Examiner erred in rejecting claims 258-261 and 267-270 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Appellants regard as the invention.
 - This pertinent issue turns on whether the use of the term “singulating” renders the claims indefinite.
- Whether the Appellants have sustained the burden of showing that the Examiner erred in rejecting claims 258-261 and 267-270 under 35 U.S.C. § 103(a) as unpatentable over Smith and Avnet.

² The Examiner has also included the reference Tran et al. (US 5,440,108) as a cited reference but has not relied on this reference in the rejection of the claims.

- This pertinent issue turns on whether Smith and Avnet describes limitations [1], [2], and [5] of the claim 258.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Facts Related to Appellants' Disclosure

01. A hopper receives coins of mixed denominations and feeds them through central openings in a housing and coin guiding member in the form of an annular sorting head or guide plate inside or underneath the housing (Specification 126:6-10 and Figs. 58-60)

Facts Related to the Prior Art

Avnet

02. Avnet is directed to a method and apparatus for dispensing cash cards (Avnet 1:17-19).

03. Avnet describes an apparatus for dispensing cash cards (Avnet 2:64-66). The apparatus provides a user with payment options for the purchase of a cash card or for adding credit to a cash card (Avnet 3:34-37). When a cash card is purchased, it is dispensed by a cash card dispensing unit (Avnet 3:43-45). If the user chooses to add value to the cash card, the user inserts the cash card into the apparatus and the apparatus evaluates and adjusts the value of the cash card accordingly (Avnet 3:45-51).

1 *Smith*

2 04. Smith is directed to unattended dispensing machines that permit
3 access using a plurality of payment means including data cards
4 (Smith 1:24-28).

5 05. Smith describes a machine for dispensing products or services,
6 such as a data card (Smith 6:53-56). The machine includes a coin
7 acceptor and a dispensing controller (Smith 9:31-36). A bill
8 acceptor may also be connected to the coin acceptor (Smith 9:60-
9 63). The coin acceptor is an apparatus which is capable of
10 receiving coins and processing the coin inputs so as to determine
11 the validity and value of the coins and further determines the total
12 monetary deposit (Smith 10:31-44). The coin acceptor further
13 provides information relating to the coins received (Smith 10:31-
14 44). The advantage of including a coin acceptor is that items can
15 be purchased using pocket change (Smith 10:48-50).

16 *Facts Related To The Level Of Skill In The Art*

17 06. Neither the Examiner nor the Appellants have addressed the
18 level of ordinary skill in the pertinent arts of vending systems and
19 financial products. We will therefore consider the cited prior art as
20 representative of the level of ordinary skill in the art. *See Okajima*
21 *v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he
22 absence of specific findings on the level of skill in the art does not
23 give rise to reversible error ‘where the prior art itself reflects an
24 appropriate level and a need for testimony is not shown’”)

(quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755
F.2d 158, 163 (Fed. Cir. 1985).

Facts Related To Secondary Considerations

07. There is no evidence on record of secondary considerations of
non-obviousness for our consideration.

PRINCIPLES OF LAW

Written Description

The first paragraph of 35 U.S.C. 112 requires that the specification
shall contain a written description of the invention. This requirement is
separate and distinct from the enablement requirement. *See, e.g., Vas-Cath,
Inc. v. Mahurkar*, 935 F.2d 1555, 1560 (Fed. Cir. 1991).

The “written description” requirement implements the principle
that a patent must describe the technology that is sought to be
patented; the requirement serves both to satisfy the inventor's
obligation to disclose the technologic knowledge upon which
the patent is based, and to demonstrate that the patentee was in
possession of the invention that is claimed.
Capon v. Eshhar, 418 F.3d 1349, 1357 (Fed. Cir. 2005).

One shows that one is “in possession” of *the invention* by
describing *the invention*, with all its claimed limitations, not
that which makes it obvious. [*Vas-Cath Inc. v. Mahurkar*, 935
F.2d 1555, 1563-64 (Fed. Cir. 1991)] (“[T]he applicant must
also convey to those skilled in the art that, as of the filing date
sought, he or she was in possession of *the invention*. The
invention is, for purposes of the ‘written description’ inquiry,
whatever is now claimed.”) (emphasis in original). One does
that by such descriptive means as words, structures, figures,
diagrams, formulas, etc., that fully set forth the claimed
invention. Although the exact terms need not be used *in haec
verba*, *see Eiselstein v. Frank*, 52 F.3d 1035, 1038 . . .
(Fed.Cir.1995) (“[T]he prior application need not describe the

1 claimed subject matter in exactly the same terms as used in the
2 claims”), the specification must contain an equivalent
3 description of the claimed subject matter.

4 *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997)

5 It is the disclosures of the applications that count. Entitlement
6 to a filing date does not extend to subject matter which is not
7 disclosed, but would be obvious over what is expressly
8 disclosed. It extends only to that which is disclosed. While the
9 meaning of terms, phrases, or diagrams in a disclosure is to be
10 explained or interpreted from the vantage point of one skilled in
11 the art, all the limitations must appear in the specification. The
12 question is not whether a claimed invention is an obvious
13 variant of that which is disclosed in the specification. Rather,
14 [an] application itself must describe an invention, and do so in
15 sufficient detail that one skilled in the art can clearly conclude
16 that the inventor invented the claimed invention as of the filing
17 date sought.

18 *id* at 1571-72.

19 *Indefiniteness*

20 The test for definiteness under 35 U.S.C. § 112, second paragraph, is
21 whether “those skilled in the art would understand what is claimed when the
22 claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety*
23 *Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations
24 omitted).

25

26 *Obviousness*

27 A claimed invention is unpatentable if the differences between it and
28 the prior art are “such that the subject matter as a whole would have been
29 obvious at the time the invention was made to a person having ordinary skill

1 in the art.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007); *Graham*
2 *v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

3 In *Graham*, the Court held that that the obviousness analysis is
4 bottomed on several basic factual inquiries: “[(1)] the scope and content of
5 the prior art are to be determined; [(2)] differences between the prior art and
6 the claims at issue are to be ascertained; and [(3)] the level of ordinary skill
7 in the pertinent art resolved.” *Graham*, 383 U.S. at 17. *See also KSR*, 550
8 U.S. at 406. “The combination of familiar elements according to known
9 methods is likely to be obvious when it does no more than yield predictable
10 results.” *KSR*, 550 U.S. at 416.

11 ANALYSIS

12 *Claims 258-261 and 267-270 rejected under 35 U.S.C. § 112, first*
13 *paragraph, for failing to comply with the written description requirement*

14 The Examiner found that the specification fails to describe the features
15 of a bulk coin receptacle and the acceptance of bulk coins. Ans. 3-4. The
16 Appellants contend that the specification describes a bulk coin receptacle
17 (“hopper”) and the acceptance of bulk coins such that a person with ordinary
18 skill in the art would have understood the Appellants were in possession of
19 the claimed invention. App. Br. 5-11 and Reply Br. 2-13

20 We agree with the Appellants. The specification describes that mixed
21 coins are input into a hopper. FF 01. A bulk coin receptacle can be any
22 receptacle that can hold a plurality of coins. Figures 58-60 explicitly show
23 that the hopper is capable of holding a plurality of mixed coins and a hopper
24 accepts a plurality of coins. FF 01. As such, a person with ordinary skill in

1 the art would have understood that the Appellants had possession of the
2 claimed invention by the written disclosure.

3 The Appellants have sustained the burden of showing that the Examiner
4 erred in rejecting claims 258-261 and 267-270 under 35 U.S.C. § 112, first
5 paragraph, for failing to comply with the written description requirement.

6
7 *Claims 258-261 and 267-270 rejected under 35 U.S.C. § 112, second*
8 *paragraph, as being indefinite for failing to particularly point out and*
9 *distinctly claim the subject matter which the Appellants regard as the*
10 *invention*

11 The Examiner found that claims 258-261 and 267-270 recite the term
12 “singulating” which is not found in an English dictionary and is not defined by
13 the specification. Ans. 4. The Examiner found that without a specific
14 definition in the specification for this term, the recited claims are indefinite
15 as recited. Ans. 4. The Appellants contend that the term “singulation” is a
16 common term in the art and the specification provides a context for the
17 usage of the term. App. Br. 12-14. The Appellants further provide a
18 reference in the art that uses the term “singulation” in support of the
19 contention that this term is known in the art. Reply Br. 14-17.

20 We agree with the Appellants. The test for indefiniteness requires that a
21 person of ordinary skill in the art would understand what is being claimed.
22 Martin et al., as noted by the Appellants describes the usage of the term
23 “singulating” to mean to make single and not commingled with other coins.
24 Reply Br. 15. This meaning of the term “singulating” is consistent with its
25 usage in the present invention. Although the Examiner found that this term

1 has multiple meanings, the test for indefiniteness is whether a person of
2 ordinary skill in this art would understand what is being claimed. Since the
3 Appellants have demonstrated that this term is known a person with ordinary
4 skill in the art, claims 258-261 and 267-270 are not indefinite.

5 The Appellants have sustained the burden of showing that the Examiner
6 erred in rejecting claims 258-261 and 267-270 under 35 U.S.C. § 112,
7 second paragraph, as being indefinite for failing to particularly point out and
8 distinctly claim the subject matter which the Appellants regard as the
9 invention.

10
11 *Claims 258-261 and 267-270 rejected under 35 U.S.C. § 103(a) as*
12 *unpatentable over Smith and Avnet*

13 The Appellants first contend that (1) Smith fails to describe the
14 dispensing of any items, including dispensing cards, as required by
15 limitation [5] of claim 258 (App. Br. 16 and Reply Br. 20-22) and (2) the
16 Examiner has not established a prima facie case of obviousness and has
17 relied on impermissible hindsight in constructing an obviousness rejection
18 (Reply Br. 17-18 and App. Br. 17-18). We disagree with the Appellants.

19 First, the Examiner has relied on Avnet to describe the dispensing of a
20 card with a stored monetary value, where Avnet describes the dispensing of
21 cash cards that have a stored monetary value associated with the card. FF
22 03. As such, the Appellants' contention that Smith fails to describe this
23 feature does not persuade us of error on the part of the Examiner because the
24 Appellants are responding to the rejection by attacking the references
25 separately, even though the rejection is based on the combined teachings of

1 the references. Nonobviousness cannot be established by attacking the
2 references individually when the rejection is predicated upon a combination
3 of prior art disclosures. *See In re Merck & Co. Inc.*, 800 F.2d 1091, 1097
4 (Fed. Cir. 1986).

5 Smith is concerned with providing customers with a dispensing
6 apparatus that accepts multiple forms of payment. FF 04. Smith
7 accomplishes this by providing a dispensing machine that includes several
8 payment options, including a coin acceptor which discussed in more detail
9 *infra*. FF 05. Avnet is also concerned with providing a product through the
10 use of a vending machine. FF 02. Avnet also provides a machine that
11 accepts payment for the purchase of a cash card or for adjusting the value of
12 a cash card. FF 03.

13 A person with ordinary skill in the art would have recognized to
14 combine Smith and Avnet in order to have similar dispensing machines
15 dispense additional products, including cards with a monetary value. As
16 such, a person with ordinary skill in the art would have found it obvious to
17 combine Smith and Avnet. Furthermore, since both Smith and Avnet are
18 concerned with dispensing machines, a person with ordinary skill in the art
19 would have been lead from Smith to Avnet to incorporate advantages
20 provided by Avnet. Dispensing a cash card is one such advantage. As such,
21 the Examiner did not merely reconstruct the claimed invention using
22 impermissible hindsight. Furthermore, the Examiner made these fact
23 findings and provided this rationale for combining the prior art thereby
24 properly establishing a prima facie case of obviousness.

1 The Appellants additionally contend that (3) Smith and Avnet fail to
2 describe singulating the bulk coins using a coin separation device, as
3 required by limitation [2] of claim 258. App. Br. 18-19 and Reply Br. 19.
4 We disagree with the Appellants. Smith describes a dispensing machine that
5 includes a coin acceptor. FF 05. The coin acceptor receives coins input by a
6 customer. FF 05. The coin acceptor further determines the validity and
7 value of each coin. FF 05. That is, the coin acceptor must examine each
8 coin individually.

9 The individual examination of each coin suggests that each coin is
10 separately evaluated, which also requires that the coins are physically
11 separated. The coins can further be separated based on whether a coin is
12 valid or not. FF 05. As such, the coin acceptor serves as a device that
13 separates coins in multiple ways. The Appellants also argue that coins in
14 Smith are not sorted; however, the claims do not require a feature of sorting
15 the coins. As such, this argument is not found persuasive.

16 The Appellants contention that Avnet fails to describe this limitation is
17 not found persuasive since the Examiner has relied on Smith to describe this
18 limitation. Nonobviousness cannot be established by attacking the
19 references individually when the rejection is predicated upon a combination
20 of prior art disclosures. *Id.*

21 The Appellants also contend that (4) Smith and Avnet fail to describe
22 limitation [1] of claim 258 and the same limitation in claims 268-270. App.
23 Br. 18-19 and Reply Br. 19-20. We disagree with the Appellants.
24 Limitation [1] requires receiving money, input substantially simultaneously
25 by a customer, in a bulk coin receptacle, where the coins are randomly

1 oriented. Smith describes a coin acceptor that receives customer input coins
2 and determines the validity and value of each coin. FF 05. Smith further
3 contemplates that the coin acceptor can accept a plurality of coins, such as
4 an amount equal to pocket change. FF 05.

5 Under the broadest reasonable interpretation, a bulk coin receptacle can
6 mean a coin acceptor capable of receiving a plurality of coins, such as the
7 number of coins in pocket change. Also, under the broadest reasonable
8 interpretation randomly oriented coins include coins of different validity and
9 different value. As such, Smith describes a coin acceptor that is capable of
10 receiving a bulk amount of coins that may be randomly oriented. The coins
11 are input for a single transaction, which is in a substantially simultaneous
12 time frame. As such, Smith describes this feature of claims 258-261 and
13 267-270.

14 The Appellants contention that Avnet fails to describe this limitation is
15 not found persuasive since the Examiner has relied on Smith to describe this
16 limitation. Nonobviousness cannot be established by attacking the
17 references individually when the rejection is predicated upon a combination
18 of prior art disclosures. *Id.*

19 The Appellants have not sustained the burden of showing that the
20 Examiner erred in rejecting claims 258-261 and 267-270 under 35 U.S.C.
21 § 103(a) as unpatentable over Smith and Avnet.

22

CONCLUSIONS OF LAW

The Appellants have sustained the burden of showing that the Examiner erred in rejecting claims 258-261 and 267-270 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement.

The Appellants have sustained the burden of showing that the Examiner erred in rejecting claims 258-261 and 267-270 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Appellants regard as the invention.

The Appellants have not sustained the burden of showing that the Examiner erred in rejecting claims 258-261 and 267-270 under 35 U.S.C. § 103(a) as unpatentable over Smith and Avnet.

DECISION

To summarize, our decision is as follows.

- The rejection of claims 258-261 and 267-270 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement is not sustained.
- The rejection of claims 258-261 and 267-270 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Appellants regard as the invention is not sustained.
- The rejection of claims 258-261 and 267-270 under 35 U.S.C. § 103(a) as unpatentable over Smith and Avnet is sustained.

